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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,424	03/02/2006	Ulrich Riebel	032301.445	9795
25461 7590 03/10/2010 SMITH, GAMBRELL & RUSSELL SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592				
EXAMINER RUMP, RICHARD M				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
03/10/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/570,424

## Applicant(s)

RIEBEL ET AL.

## Examiner

Richard M. Rump

## Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-53 is/are pending in the application.
- 4a) Of the above claim(s) 25-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Status of Application***

Claims 51-53 are pending and presented for examination. Claims 51-52 were elected with traverse. Applicant amended claim 51 and added claim 52 via amendment filed on 15 January 2009. As such claims 25-50 were withdrawn.

### ***Response to Arguments***

Applicant's arguments filed on 15 January 2009 have been fully considered but they are not persuasive.

Firstly, Applicant traverses the restriction requirement. There is no earnest argument supplied by Applicant beyond linking claim 51 to 25. This is not persuasive and only affords Applicant the right to a rejoinder of Group I IF Group II (claims 51-53) are found allowable.

Applicant's election with traverse of Group II claims 51-52 in the reply filed on 15 January 2009 is acknowledged. The traversal is on the ground(s) that claim 51 has been amended to include a linking claim. Although this may be true, a further search yielded EP 1055877 (See below) which clearly discloses the common technical feature.

**The requirement is still deemed proper and is therefore made FINAL.**

Applicant's argument that the 112(2) rejection be withdrawn has been persuasive. As such that rejection is withdrawn. Applicant's arguments in view of Hisashi are persuasive.

***Claim Objections***

Applicant is advised that should claim 53 be found allowable, claim 51 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 51 & 53 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative under 35 USC 103(a) as being unpatentable over EP1055877 (US 6946101) to Jing with “Industrial Carbon” as an evidentiary reference.**

Regarding claims 51 & 53, Jing discloses a process and device to create a carbon black soot (aerosol). The carbon black is as synthesized and is entrained in a heated oxygen environment (column 5, lines 40-49; column 6, lines 22-44; figure 1) which would create oxy groups which would inherently result in a low pH (less than six) and there would be

no later loss on ignition due to this pre-burning stage. Carbon black will inherently meet the less than 200 ppm sieve residue requirement as synthesized carbon black has sizes of less than 60 nm as evidenced by NPL U. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) also MPEP 2113, *et seq.* As shown *supra* the product is known.

**Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jing/Industrial Carbon with Hisashi .**

Regarding claim 52, Jing does not expressly state a member selected from the group consisting of rubber, plastic, printing ink, ink, inkjet ink, toner, finish, paint, paper, bitumen, concrete or other construction materials. Given the similar carbon black produced it would be obvious to a skilled artisan that the carbon black of Jing would be applicable in any of these uses (specifically toner) as it is a low pH carbon black as evidenced by Hisashi (abstract).

***Conclusion***

Claims 51-53 have been rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard M. Rump whose telephone number is (571) 270-5848. The examiner can normally be reached on Monday through Friday 7:00 AM-4:30 PM (-5 GMT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571)272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/R. M. R./  
Examiner, Art Unit 1793

/Stuart Hendrickson/  
Primary Examiner, Art Unit 1793